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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,624	07/24/2003	Elizabeth A. Colbert	015291-112	8076
21839 7590 01/23/2007 BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404			EXAMINER RUDDOCK, ULA CORINNA	
			ART UNIT	PAPER NUMBER
			1771	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/23/2007	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/625,624		COLBERT, ELIZABETH A.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Ula C. Ruddock		1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 20-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: ____.  |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :12/15/03,3/8/04,1/5/05,8/15/05,1/11/06,8/9/06.

### DETAILED ACTION

1. Applicant's election without traverse of Group I, claims 1-19, in the reply filed on October 10, 2006, is acknowledged.

#### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-31 and 51-53 of copending Application No. 10/823428. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are obvious variants over one another.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9, 19-27, 37-46, and 56-62 of copending Application No. 10/824193. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are obvious variants over one another.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1-19 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-37 and 51-53 of copending Application No. 10/824336. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are obvious variants over one another.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-7, 9, and 12-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Francis et al. (US 4,287,103) in view of McKinnon (US 3,839,141). Francis et al. disclose wallboard comprising a gypsum core sandwiched between paper facings (col 1, ln 9-10), wherein the paper

facing is coated with a joint composition (col 1, ln 17-26). The joint composition comprises filler material, adhesive binder, and water. As seen in Table 1, water is present in the composition in the amount of 33.5-35.5% by weight. The preferred filler is gypsum or limestone (i.e. calcium carbonate) (col 5, ln 19-25) in the amount of 25-93% by weight (col 5, ln 21). Mica or talc are also added to the composition (col 4, ln 42) in the amount of 5-50%. The binder, which is latex (see col 2, ln 60), is present in the amount of 2-12% by weight. It should be noted that in claim 6 of the present invention, filler (0-30%) and additives (0-10%) are being treated as optional components since they can be present in the composition in the amount of 0%. Also, in claim 9, limestone (0-50%), clay (0-10%), other fillers (0-30%), and additives (0-10%) are being treated as optional components since they can be present in the composition in the amount of 0%. Francis et al. disclose the claimed invention except for the specific teaching that the coating penetrates through at least a portion of the facing sheet and into the gypsum core.

It would have been obvious to one having ordinary skill in the art to have the joint composition of Francis penetrate through the paper and into the gypsum core, motivated by the desire to create a wallboard material that has increased lamination strength and tear resistance. Because the same materials are being used as the facing sheet (paper) and coating (joint compound), the coating would penetrate therethrough.

Regarding claims 3 and 4, Francis et al. do not disclose the specific coating thickness. However, in the absence of unexpected results it would have been obvious to one having ordinary skill in the art to have made the thickness of the coating up to 30 mils or preferably 3-20 mils, since it has been held that where the general conditions of a claim are disclosed in the prior art,

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discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233. In the present invention, one would have optimized the coating thickness motivated by the desire to create a wallboard material that has decreased delamination and increased strength.

Regarding claims 12, 13, 15, 18, although Francis does not explicitly teach the claimed level 4 or level 5 finish, it is reasonable to presume that this property is inherent to the invention of Francis. Support for said presumption is found in the use of like materials (i.e. gypsum board, paper facing, and a coating comprising water, gypsum or limestone, latex binder, clay or mica or talc, and other additives). The burden is upon Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In addition, the presently claimed property of a facing sheet with a level 4 or level 5 finish, would obviously have been present once the Francis product is provided. Note *In re Best*, 195 USPQ at 433, footnote 4 (CCPA 1977).

8. Claims 8, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Francis et al. (US 4,287,103) in view of Zuber et al. (US 6,105,325). Francis et al. disclose the claimed invention except for the teaching that the composition comprises a pigment material and that the paper is an unbleached grey paper.

Zuber et al. (US 6,105,325) disclose a plasterboard material comprising a plaster body and at least one sheet of lining paper (i.e. facing) comprising a mineral filler of light color (abstract). The pigment layer comprises a white mineral filler (col 3, ln 60-63). In addition, one of the sheets of paper can be unbleached grey paper (col 3, ln 25-28). It would have been obvious to one having ordinary skill in the art to have used the pigment of Zuber in the composition of Francis, motivated by the desire to create a joint composition that has the desired tint. It also would have



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been obvious to one having ordinary skill in the art to have made the paper of Francis be the unbleached grey paper of Zuber, motivated by the desire to create a wallboard material that has cheaper manufacturing costs, due to not bleaching the paper.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ula C. Ruddock whose telephone number is 571-272-1481. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

UCR *ucr*

*Ula Ruddock*  
**Ula C. Ruddock**  
Primary Examiner  
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